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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	**William HILL et al.**	Atty. Docket No.:	003797.00335
Serial No.:	09/479,979	Group Art Unit:	2176
Filed:	January 10, 2000	Examiner:	C. Huynh
For:	METHOD AND SYSTEM FOR DYNAMICALLY ADAPTING THE LAYOUT OF A DOCUMENT TO AN OUTPUT DEVICE	Confirmation No.:	3757

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APPEAL BRIEF

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Sir:

This is an Appeal Brief in accordance with 37 C.F.R. § 1.192, filed in triplicate in support of appellants' April 5, 2004 Notice of Appeal. Appeal is taken from the Final Office Action mailed December 4, 2003, and the Advisory Action mailed March 26, 2004. Please charge any necessary fees in connection with this Appeal Brief to our Deposit Account No. 19-0733.

I. REAL PARTY IN INTEREST

The owner of this application, and the real party in interest, is Microsoft Corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

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III. STATUS OF CLAIMS

Claims 35-53 are rejected; claims 1-34 are canceled. All of the pending claims, claims 35-53, are shown in the attached appendix.

Claims 35-53 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Spyglass Prism, *Concepts and Applications* (pages 1-8) and Spyglass Prism 1.0 (pages 1 and 2), 3/1997 (hereinafter Spyglass) in view of *Elements of Editorial Style For Computer-Delivered Information*, IEEE, March 1990 to Carliner.

Appellants hereby appeal the rejections of claims 35-53.

IV. STATUS OF AMENDMENTS

There are no amendments subsequent to the final Office Action of December 4, 2003 and all prior amendments have been entered.

V. SUMMARY OF INVENTION

In making reference herein to various portions of the specification and drawings in order to explain the claimed invention (as required by 37 C.F.R. § 1.192(c)(5)), Appellants do not intend to limit the claims; all references to the specification and drawings are illustrative unless otherwise explicitly stated.

The invention is directed to dynamically adapting the layout of a document to a particular output device. *Specification*, page 1, lines 17-20. In an illustrative implementation of the invention, a method for formatting a document adapts the document layout to the destination

display device "by selecting a style sheet based upon the capabilities of the display device and displaying the document using the selected style sheet." *Specification*, page 3, lines 15-18. As stated in the specification at page 10:

> [a] style sheet is a collection of style definitions which provides instructions for formatting a document. . . . A style sheet may define the format properties of a document such as font properties (font family, font style, font variant, font weight, font size), color and background properties (background color, background position), text properties (word spacing, letter spacing), and page properties (columns, page margins).

Specification, page 10, lines 15-23.

According to one illustrative embodiment of the invention, the dynamic adaptation can take place in a networking environment as shown in Fig. 2 including a client 204, server 208, an output device, 200, a document 210, and style sheets 214a, 214b . . . 214n. In the Fig. 2 system, the document 210 can include a layout generator 212. In this instance, the layout generator 212 can interrogate the display device to determine its capabilities and select an appropriate style sheet 214a, 214b . . . 214n based upon the device capabilities. *Specification*, page 14, lines 23-25.

In another illustrative embodiment of the invention in a networking environment as depicted in Fig. 3, the document 210 can include a layout generator 300 having a style generator 304. *Specification*, page, 15, lines 13-14. Differently from the layout generator 212 of Fig. 2, the layout generator 300 creates rather than selects a style sheet. More specifically, "the layout generator 300 interrogates the display device 200 and generates style definitions 306a, 306b . . . 306n appropriate for the capabilities of the display

device." *Specification*, page 15, lines 19-22. The layout generator shown in Figs. 2 and 3 may be executed by the client 204 in a client-controlled embodiment or by the server 206 in a server-controlled embodiment. *Specification*, page 15, lines 28-30.

Fig. 4 shows an illustrative method of the invention in a client-controlled embodiment and Figs. 5 and 6 each show an illustrative method of the invention in a server-controlled embodiment.

In the client-controlled embodiment of Fig. 4, the client requests a document (step 402) and receives the document including an embedded layout generator (step 404). *Specification*, page 16, lines 1-5. Using the layout generator, the client interrogates the output device to determine the device's capabilities (step 406), selects a style sheet based on the device's capabilities (step 408) the style sheet being linked to the document, and requests the selected style sheet from the server (step 410). *Specification*, page 16, lines 5-20. After receiving the selected style sheet (step 412), the client renders the document on the output device using the selected style sheet (step 414). *Specification*, page 16, lines 20-23.

In the server-controlled embodiment of Fig. 5, the server receives a client request for a document (step 502) and retrieves the document including an embedded layout generator (step 504). *Specification*, page 17, lines 34-37. The server executes the layout generator in steps 506-510 by interrogating the output device to determine the device's capabilities (step 506), selecting a style sheet based on the device's capabilities (step

508), and sending the selected style sheet and document to client (step 510), the style sheet and the document being linked. *Specification*, page 16, line 37 to page 17, line 18. Thereafter, the client renders the document on the output device using the selected style sheet (step 512). *Specification*, page 18, lines 18-19.

In a variation of a method applied in the server-controlled embodiment as depicted in Fig. 6, the layout generator may include a style generator, which creates a style sheet using a series of style definitions instead of selecting a style sheet. *Specification*, page 18, lines 22-25. Steps 600-606 of the Fig. 6 method are similar to steps 500-506 of the Fig. 5 method. *Specification*, page 18, lines 25-26. After interrogating the output device however, the server generates style definitions, which are used to create a style sheet (step 608). *Specification*, page 18, lines 32-34. Next, the server sends the selected style sheet and document to client (step 610) where the client renders the document on the output device using the selected style sheet (step 612). *Specification*, page 19, lines 3-5.

VI. ISSUES

1) Whether the combination of Spyglass and Carliner pursuant to 35 U.S.C. § 103(a) renders the invention of claims 35-53 unpatentable.

VII. GROUPING OF CLAIMS

In accordance with 37 C.F.R. § 1.192(c)(7), Appellant respectfully asserts that the claims do not stand or fall together. Thus, the following groups of separately patentable claims should be recognized:

GROUP I -- Claims 35-41.

GROUP II -- Claims 42-53.

In accordance with 37 C.F.R. § 1.192(c)(7) - (8), separate arguments for patentability for Groups I and II are provided, *infra*.

VIII. ARGUMENT

A. *Claims 35-41*

Independent claim 35 is directed to a method for formatting a document for presentation on an output device. Claim 35 calls for, *inter alia*, the steps of determining a set of capabilities of the output device; selecting one of a plurality of style sheets based upon the set of capabilities of the output device; and formatting the document for presentation on the output device using the selected style sheet.

The final office action contends that Spyglass shows all the elements of independent claim 35, "but does not disclose selecting one of a plurality of style sheets based upon the set of capabilities of the output device." *Final Office Action*, p. 3, ¶6. To overcome this deficiency, the action relies on Carliner.

Spyglass describes a proxy server application that automatically adapts Internet content originally formatted for a PC to a format that matches the capabilities of a device (e.g., TVs, phones, PDAs and pagers) requesting the content. The application (Spyglass Prism) performs the following functions:

1. Upon requesting a URL, a non-PC device connects to an Internet access provider's server where Spyglass Prism resides.
2. Once connected, the device identifies itself and the user to Spyglass Prism. This information is cross referenced against two different databases. The first is the User Database, used to track information such as the user preferences. The second database is the Device Database. This database contains the characteristics of various devices, such as display, resolution, color or monochrome support, and text or graphics display.
3. Using its own fully functional Web browser component, Spyglass Prism accesses the URL requested by the user.
4. After retrieving the data, Spyglass Prism uses its stored data about the Web site, the user and the device to convert the data into the best format for the device.

Spyglass Prism, Concepts and Applications, p. 2.

Carliner describes why a different editorial style needs to be used to format computer-delivered information on a computer display than for a printed page. To account for the stylistic differences between a computer display and a printed page, Carliner provides an approach for developing a style sheet for information delivered on a computer display.

The final office action alleges that "Carliner discloses the style sheets for writing computer delivered information where the targets of delivering information are different output devices such as different computer displays or printers with different capabilities." *Final Office*

Action, at p. 4. In addition, the final office action acknowledges that Carliner does not teach or suggest selecting one of a plurality of style sheets based upon the set of capabilities of the output device. Before combining Carliner with Spyglass, the action contends that it would have been obvious to modify Carliner to include selecting one of a plurality of style sheets based upon the set of capabilities of the output device. According to the final office action, one would have modified Carliner because "[w]riting computer-delivered information using the style sheets for formatting the information where the information is rendered differently on different output devices suggests that an appropriate style sheet be selected to match the characteristics of the output device." *Final Office Action*, p. 4.

After having modified Carliner, the action then alleges that it would have been obvious to combine Spyglass and Carliner since Carliner provides the style sheets for delivering computer information to a computer display or printer and Spyglass determines the capabilities of an output device connected to a computer. The combination of Spyglass and Carliner according to the action would have resulted in "a method for formatting a document according to the style sheet that can be changed to match the characteristics of the output device." *Id.*

Appellants submit that the combination as proposed is improper. In particular, the action has modified Carliner prior to combining it with Spyglass and only by modifying Carliner was the action able to assert that Carliner included such a feature. In an obviousness rejection however, the references when combined must teach or suggest all limitation of the claim. In this

instance, the action has modified Carliner and then modified Spyglass with Carliner as modified contrary to the requirements to establish a *prima facie* case of obviousness.

In addition, appellants submit that the combination of Spyglass and Carliner would not have resulted in the claim 35 invention because the action makes the inaccurate representation that Carliner provides the style sheets for delivering computer information to a computer display or printer. Contrary to the assertion in the final office action, Carliner neither teaches nor suggests providing style sheets for delivering computer information to a computer display *or* printer. At most, Carliner has identified a need for a different style guide for computer-delivered information as opposed to books, magazines and the like. Indeed, Carliner recognizes that the style guides developed for publishing such as *The Chicago Manual of Style* and *Elements of Style* were developed for people who write printed materials and that no editorial reference such as these exist for computer-delivered information. Furthermore, Carliner discusses the physical differences between the computer display and the traditional printed page which warrant different treatment for computer-delivered information. Yet Carliner does not discuss much less contemplate the idea of a *system or method involving selecting* one style sheet for a printer and a separate style sheet for a display. Carliner merely suggests that information in a computer-delivered medium should have its own style different from the style of information delivered in a print medium. Notably, no teaching or suggestion is provided that the styles exist in the same system such that different styles are selected based upon the set of capabilities of the output

device. In light of the foregoing, the combination of Spyglass and Carliner does not result in the invention of claim 1.

Even assuming, but not admitting, that the proposed combination would have resulted in the invention of claim 35, appellants submit that one skilled in the art would not have had incentive or been motivated to modify Spyglass to include selecting one of a plurality of style sheets based upon the set of capabilities of the output device as allegedly found in Carliner. The action contends that modifying Spyglass to include Carliner "would provide a method for formatting a document according to the style sheet that can be changed to match the characteristics of the output device." *Final Office Action*, p. 4. Tellingly, Spyglass has *no need for selecting style sheets based upon the set of capabilities of the output device*. Nor has the action identified any motivation or incentive as to why one would have modified Spyglass to include such a feature. Notably, with the application Spyglass Prism disclosed in Spyglass a non-PC device identifies itself and the user to Spyglass Prism. This information is cross referenced against the User Database and the Device Database. Subsequently, Spyglass Prism uses its stored data about the Web site, the user and the non-PC device to convert the data into the best format for the non-PC device. Thus, Spyglass already has its own mechanism for converting content into an appropriate format to match the capabilities of the target device. Hence, appellants submit that there is no reason why one skilled in the art would have modified Spyglass with Carliner in the manner suggested in the action to obtain the claim 35 invention.

Moreover, the action contends that it would have been obvious to have combined Spyglass with Carliner since Carliner provides the style sheets for delivering computer information to a computer display or printer and Spyglass determines the capabilities of an output device connected to a computer. This contention however does not represent motivation to combine the references, and thus making the combination proposed in the action constitutes nothing more than an exercise of impermissible hindsight. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The action has taken appellants' claim 35 invention and hunted through the prior art in an attempt to construct the invention without providing any motivation or incentive why one would have combined Spyglass and Carliner at the time of the invention.

In light of the foregoing, claim 35 is patentably distinct from the applied combination. Furthermore, claims 36-42, which ultimately depend from claim 35, are allowable over the art of record for the same reasons as set forth with respect to claim 35, and further in view of the advantageous features recited therein.

B. ***Claims 42-53***

The action applied the combination Spyglass and Carliner to reject independent claim 42 for some of the same reasons as independent claim 35. Not surprisingly, claim 42 is patentably distinct from the combination of Spyglass and Carliner for at least some of the same reasons set forth with respect to claim 35.

Independent 42 calls for, among other features, selecting a layout generator and generating a selected style sheet based upon the set of capabilities of the output device using the

layout generator. To show these features, the action alleges that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Carliner and Spyglass to incorporate selecting a layout generator for generating the selected style sheet based upon the set of the capabilities of the output device." *Final Office Action*, p. 7. This statement made in the action is unsupported by any teaching or suggest in either Spyglass or Carliner. Moreover, no motivation or incentive is identified as to why one skilled in the art would have been motivated to modify the combination of Spyglass and Carliner to employ a layout generator. The action further avers that "generating the selected style sheet based upon the capabilities of the output device is inherently performed in adapting the format of web documents to different output devices as the function of the layout generator." *Id.*, at p. 8. Appellants respectfully disagree. To show that "generating" is inherent, the action must establish that "generating" must be performed in adapting the format of web document to different output devices; the mere possibility is not enough. In this regard, appellants submit that a selected style sheet may already exist and not need to be generated to adapt the format of web documents to different output devices.

In addition to the reasons that apply from claim 35, claim 42 is patentably distinct from the combination of Spyglass and Carliner. Also, claims 43-47 are considered allowable for the same reasons as claim 42, and further in view of the advantageous features recited therein.

The action applied the combination Spyglass and Carliner to reject independent claim 48 for some of the same reasons as independent claims 35 and 42. Not surprisingly, claim 48 is

patentably distinct from the combination of Spyglass and Carliner for at least the same reasons set forth with respect to claims 35 and 42 that apply to claim 48. Also, claims 49-53 are considered allowable for the same reasons as claim 48, and further in view of the advantageous features recited therein.

IX. CONCLUSION

For all of the foregoing reasons, Appellants respectfully submit that the final rejection of claims 35-53 is improper and should be reversed.

Respectfully submitted,

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Dated: June 4, 2004

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APPENDIX

CLAIMS INVOLVED IN THE APPEAL

35. A method for formatting a document for presentation on an output device comprising:

determining a set of capabilities of the output device;

selecting one of a plurality of style sheets based upon the set of capabilities of the output device; and

formatting the document for presentation on the output device using the selected style sheet.

36. The method of Claim 35, wherein a layout generator is used for determining a set of capabilities of the output device and selecting one of a plurality of style sheets based upon the set of capabilities of the output device.

37. The method of Claim 36, wherein the layout generator is external to the document.

38. The method of Claim 36, wherein the layout generator is embedded in the document.

39. The method of Claim 35, further comprising:

embedding the selected style sheet in the document.

40. The method of Claim 39, wherein embedding the selected style sheet comprises placing a style tag corresponding to the selected style sheet in the document.

41. The method of Claim 39, wherein the document includes a plurality of tags and wherein embedding the selected style sheet comprises placing style attributes corresponding to the selected style sheet in the tags of the document.

42. A method for formatting a document for presentation on an output device comprising:

selecting a layout generator;

determining a set of capabilities of the output device;

generating a selected style sheet based upon the set of capabilities of the output device using the layout generator; and

formatting the document for presentation on the output device using the selected style sheet.

43. The method of Claim 42, wherein the layout generator is a general purpose layout generator for use with a plurality of documents.

44. The method of Claim 42, wherein the layout generator is designed only for use with the document.

45. The method of Claim 42, wherein the selected style sheet is external to the document.

46. The method of Claim 42, wherein the selected style sheet is embedded in the document.

47. The method of Claim 42, wherein generating a selected style sheet comprises selecting a style definition which defines a format value for a format property, the format value supported by the set of capabilities of the output device.

48. A method for generating a style sheet used to format a document for presentation on an output device comprising:

selecting a layout generator;

interrogating the output device to determine a set of capabilities of the output device using the layout generator; and

based upon the set of capabilities of the output device, generating a style sheet having a plurality of style definitions for formatting the document for presentation on the output device.

49. The method of Claim 48, further comprising:

embedding the generated style sheet in the document.

50. The method of Claim 48, wherein the generated style sheet is external to the document.

51. The method of Claim 48, wherein generating a style sheet comprises:

selecting a style sheet from a plurality of style sheets.

52. The method of Claim 48, wherein each of the style definitions assigns a format value to a format property, and wherein generating a style sheet having a plurality of style definitions

comprises generating a plurality of style definitions with format values supported by the set of capabilities of the output device.

53. The method of Claim 48, wherein the document is a generalized markup language document.